

# **NON-PROFIT TO NON-PROFIT BIOLOGICAL MATERIAL TRANSFER AGREEMENT (BMTA)**

**Definitions:**

**PROVIDER:** Institution providing the Original Material.

Oregon Health & Science University

3181 S.W. Sam Jackson Park Road

Portland, OR 97201

**Provider's Scientist:**

Dr. Maureen Hoatlin

Oregon Health & Science University

3181 S.W. Sam Jackson Park Road, L224

Portland, OR 97201

**RECIPIENT:** Institution receiving the Original Material. (Enter name and address here)

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**Recipient's Scientist:** (Enter name and address here)

Dr. \_\_\_\_\_

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**Original Material:** (Enter description) \_\_\_\_\_

**Statement of Proposed Research:** \_\_\_\_\_

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**MATERIAL:** Original Material plus Progeny and Unmodified Derivatives. The **MATERIAL** shall not include (a) Modifications or (b) other substances created by the **RECIPIENT** through the use of the **MATERIAL** which are not Progeny or Unmodified Derivatives.

Progeny: Unmodified descendant from the **MATERIAL**, such as virus from virus, cell from cell, or organism from organism.

Unmodified Derivatives: Substances created by **RECIPIENT** which constitute an unmodified functional sub-unit or an expression product of the Original Material. Some examples include: subclones of unmodified cell lines, purified or fractionated sub-sets of the Original Material, proteins expressed by DNA/RNA supplied by **PROVIDER**, monoclonal antibodies secreted by a hybridoma cell line, sub-sets of the Original Material such as novel plasmids or vectors.

Modifications: Substances created by **RECIPIENT** which contain/incorporate the **MATERIAL** (Original Material, Progeny or Unmodified Derivatives). \_\_

### **Terms and Conditions of this Agreement**

1. The **MATERIAL** is the property of **PROVIDER** and is to be used by **RECIPIENT** solely for research purposes and only as described above and in any other description of the proposed work at **RECIPIENT's** Institution only and only under the direction of the **Recipient's Scientist**. The **MATERIAL** will not be used in human subjects or in clinical trials involving human subjects without the written permission of **PROVIDER**. **PROVIDER** [has/has not] filed patent applications claiming the **MATERIAL** or uses thereof.
2. The **Recipient's Scientist** agrees not to transfer the **MATERIAL** to anyone who does not work under his or her direct supervision at **RECIPIENT's** Institution without the prior written consent of **PROVIDER**. **Recipient's Scientist** shall refer any request for the **MATERIAL** to **PROVIDER**. To the extent supplies are available, **PROVIDER** or **Provider's Scientist** agrees to make the **MATERIAL** available under a **BMTA** to other scientists (at least those at non-profit or Governmental institutions) who wish to replicate **Recipient's Scientist's** research.
3. a. **RECIPIENT** shall have the right, without restriction, to distribute substances created by **RECIPIENT** through the use of the **MATERIAL** only if those substances are not Progeny, Unmodified Derivatives, or Modifications.  
  
b. Upon notice to **PROVIDER** and under a **BMTA** (or an agreement at least as protective of **PROVIDER's** rights), **RECIPIENT** may distribute Modifications

to non-profit or Governmental organizations for research purposes only.

c. Upon written permission from **PROVIDER**, **RECIPIENT** may distribute Modifications for commercial use. It is recognized by **RECIPIENT** that such commercial use may require a commercial license from **PROVIDER** and **PROVIDER** has no obligation to grant such a commercial license. Nothing in this paragraph, however, shall prevent **RECIPIENT** from granting commercial licenses under **RECIPIENT**'s patent rights claiming such Modifications.

4. a. Ownership of tangible property as between **PROVIDER** and **RECIPIENT** is defined in **Attachment A**.

b. **RECIPIENT** is free to file patent applications claiming inventions made by **RECIPIENT** through the use of the **MATERIAL**, but agrees to notify **PROVIDER** upon filing a patent application claiming Modifications or uses of the **MATERIAL**.

5. a. Except as expressly provided in this **Agreement**, no rights are provided to **RECIPIENT** under any patents, patent applications, trade secrets or other proprietary rights of **PROVIDER**. In particular, no rights are provided to use the **MATERIAL** or Modifications and any related patents of **PROVIDER** for profit-making or commercial purposes, such as sale of the **MATERIAL** or Modifications, use in manufacturing, provision of a service to a third party in exchange for consideration (not including sponsored research activities).

b. If **RECIPIENT** desires to use the **MATERIAL** or Modifications for such profit-making or commercial purposes, **RECIPIENT** agrees, in advance of such use, to negotiate in good faith with **PROVIDER** to establish the terms of a commercial license. It is understood by **RECIPIENT** that **PROVIDER** shall have no obligation to grant such a license to **RECIPIENT**, and may grant exclusive or non-exclusive commercial licenses to others.

6. The provision of the **MATERIAL** to **RECIPIENT** shall not alter any pre-existing right to the **MATERIAL**. If **PROVIDER** has granted any rights to a third party (other than the customary rights granted to the Federal Government or non-profit foundations) which would affect **RECIPIENT**, those rights are listed in **Attachment B**.

7. Any **MATERIAL** delivered pursuant to this **Agreement** is understood to be experimental in nature and may have hazardous properties. **PROVIDER MAKES NO REPRESENTATIONS AND EXTENDS NO WARRANTIES OF ANY KIND, EITHER EXPRESS OR IMPLIED. THERE ARE NO EXPRESS OR IMPLIED WARRANTIES OF MERCHANTABILITY OR FITNESS FOR A PARTICULAR PURPOSE, OR THAT THE USE OF THE MATERIAL WILL NOT INFRINGE ANY PATENT, COPYRIGHT, TRADEMARK, OR OTHER PROPRIETARY RIGHTS.**

8. Except to the extent prohibited by law, **RECIPIENT** assumes all liability for damages which may arise from its use, storage or disposal of the **MATERIAL**. **PROVIDER** will not be liable to **RECIPIENT** for any loss, claim or demand made by **RECIPIENT**, or made against **RECIPIENT** by any other party, due to or arising from the use of the **MATERIAL** by **RECIPIENT**, except to the extent permitted by law when caused by the gross negligence or willful misconduct of **PROVIDER**.

9. This **Agreement** shall not be interpreted to prevent or delay publication of research resulting from the use of the **MATERIAL** or Modifications. **Recipient's Scientist** agrees to provide appropriate acknowledgment of the source of the **MATERIAL** in all publications.

10. **RECIPIENT** agrees to use the **MATERIAL** in compliance with all applicable statutes and regulations, including, for example, those relating to research involving the use of animals or recombinant DNA.

11. a. This **Agreement** will terminate on the earliest of the following dates: (1) when the **MATERIAL** becomes generally available from third parties, for example, through reagent catalogs or from public depositories, or (2) on completion of **RECIPIENT**'s current research with the **MATERIAL**, or (3) on thirty (30) days written notice by either party to the other, or (4) on the following date \_\_\_\_\_. Paragraphs 7 and 8 shall survive termination.

b. If termination should occur under Paragraph 11a.(1), **RECIPIENT** shall be bound to the **PROVIDER** by the least restrictive terms applicable to **MATERIAL** obtained from the then available sources.

c. Except as provided in 11(d) below, on termination of this **Agreement** under Paragraph 11a.(2), (3), or (4) above, **RECIPIENT** will discontinue its use of the **MATERIAL** and will, upon direction of **PROVIDER**, return or destroy any remaining **MATERIAL**. **RECIPIENT** will also either destroy Modifications or remain bound by the terms of Paragraphs 4 and 5 as they apply to Modifications.

d. In the event **PROVIDER** terminates this **Agreement** under Paragraph 11a.(3) other than for breach of this **Agreement** or with cause such as an imminent health risk or patent infringement, **PROVIDER** will defer the effective date of termination for a period of up to one (1) year, upon request from **RECIPIENT** to permit completion of research in progress.

12. The **MATERIAL** is provided [with/without] a fee which [is/is not] solely to reimburse **PROVIDER** for its distribution costs. The amount of the fee, if any, is \_\_\_\_\_ (\$\_\_\_\_\_). Please provide your Federal Express, or other courier, number so that the **MATERIAL** can be shipped at

**RECIPIENT's** expense. Courier Account No.: \_\_\_\_\_

**AGREED:**

**PROVIDER:**

Institution: Oregon Health & Science University

Address: 3181 S.W. Sam Jackson Park Road

Portland, OR 97201

Authorized Official: Todd T. Sherer, Ph.D.

Title: Director, Technology & Research Collaborations

Signature: \_\_\_\_\_

Date: \_\_\_\_\_

**Provider's Scientist:**

Name: Dr. Maureen Hoatlin

Title: Associate Professor

Signature: \_\_\_\_\_

Date: \_\_\_\_\_

**RECIPIENT:**

Institution: \_\_\_\_\_

Address: \_\_\_\_\_

\_\_\_\_\_

\_\_\_\_\_

Authorized Official: \_\_\_\_\_

Title: \_\_\_\_\_

Signature: \_\_\_\_\_

Date: \_\_\_\_\_

**Recipient's Scientist:**

Name: \_\_\_\_\_

Title: \_\_\_\_\_

Signature: \_\_\_\_\_

Date: \_\_\_\_\_

Telephone No.: \_\_\_\_\_

**Attachment A:**

Belonging to **PROVIDER**

**MATERIAL**

Original Material

Progeny

Unmodified Derivatives

Belonging to **RECIPIENT\***

Modifications (however **PROVIDER** retains ownership rights to any form of the **MATERIAL** included therein)

Those substances created through the use of the **MATERIAL** or Modifications, but which are not Progeny, Unmodified Derivatives or Modifications (e.g., do not contain the Original Material or Unmodified Derivatives).

\* If resulting from the collaborative efforts of **PROVIDER** and **RECIPIENT**, joint ownership is a possibility.

**Attachment B:**

[**PROVIDER** describes any pre-existing obligations that **PROVIDER** has to third parties (other than the Federal Government or non-profit foundations) which would affect **RECIPIENT**.]

**RETURN COMPLETED FORM TO:**

Material Transfer Associate

Technology & Research Collaborations, AD 120

Oregon Health Sciences University

3181 S.W. Sam Jackson Park Road

Portland, OR 97201-3098 U.S.A.

Telephone: (503) 494-5694    Telefacsimile: (503) 494-4729